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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,576	01/21/2000	William J. Baer	STL000013US1	6006

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EXAMINER	
NGUYEN BA, PAUL H	

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/489,576	BAER ET AL.	
	Examiner	Art Unit	
	Paul Nguyen-Ba	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This action is responsive to Applicant's Arguments filed on 6/12/2006.

2. Claims 1-51 are currently pending. Claims 1, 6, 16, 21, 31, and 36 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw-Hill Primis Custom Publishing ("McGraw") (www.mhhe.com/primis), archived circa 1998, via the Wayback Machine (www.archive.org), in view of Helmick et al. ("Helmick"), U.S. Patent No. 6,470,171.

Regarding independent claim 1:

McGraw teaches a method for creating customized published textbooks (*compare with* "books") corresponding to the each particular user's needs, teaching technique, style, content, and organization (see all of pg. 1).

> *A method for adding content to a first content object stored as a first plurality of content entities in a data repository, the data repository containing a second plurality of content entities of a second content object, each of the content entities having an identifier, comprising:*
>
> - *wherein the first list of content entity identifiers comprises a plurality of content entity identifiers, and*
> - *wherein the location determined by the user is between the plurality of content entity identifiers.*

McGraw teaches a custom publishing database (*compare with* "data repository") that contains a collection of modular, stand-alone text files (*compare with* "second plurality of content entities of a second hierarchically structured content object") (see pg. 3, paragraphs 1-3 → includes textbooks, supplements, journals, magazine articles, lab manuals, case studies, literary works, and historical documents each structured such that the content entities rank or grade in a subordinate manner in a "hierarchy;" see also pgs. 5-12 → i.e. discipline, volume, chapter, section, etc.) that can be mixed and matched ***in any order*** (*compare* with "at a location determined by user") and seamlessly arranged to create a custom book (*compare with* "first hierarchically structured content object") consisting of the selected modular text files (*compare with* "first plurality of content entities") (see pg. 3, bulleted features).

Each of the "content entities" of the first and second object lists has corresponding identifiers (see pgs. 5-9, and 12 → each content identity is identified by a

unique title or name, a unique URL, and a unique Item Identifier number). A user can determine the location of identifiers simply by adding said identifiers in any order that the user prefers. In other words, if user wanted a particular identifier in the second position, user would add said identifier second. As far as resequencing content, a user is free to resequence the identifiers at a later stage. This process would thus 'add' the identifier to another location of the first list, while resequencing all the other identifiers in the list accordingly. Either method would preclude the broad claim language as set forth.

McGraw, strongly suggests (as discussed immediately below), but does not explicitly teach:

- *such that adding the content entity identifier of one of the second plurality of content entities to the first list adds the identified content entity to the first content object.*

However, McGraw teaches an "Add" hyperlink corresponding to each second object identifier (see pgs. 7, 9, and 12) for the purpose of adding the content entities of a second object to a first object "in any order" (see pg. 3). McGraw further teaches a "Review" hyperlink for the purpose of reviewing the contents of the first object of the custom publishing process. It was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to define the first object by a first list of content entity identifiers organized as an outline of containers such that adding the content entity identifier of one of the second plurality of content entities to the first list outline adds the identified

content entity to the first content object at a location determined by a user for the express motivational purpose of an efficient and direct means for adding (i.e., mixing or matching) the content entities of a second object to a first object "in any order" to create a customized text book from user selected portions of other texts or materials (i.e., objects).

Moreover, Helmick also teaches an on-line system for display of educational materials wherein a user can use a course manager screen in order to build an electronic syllabus (see Figs. 3V-3X). Fig. 3X specifically teaches an add content screen used to add or modify content for particular identified units of a course and thus build a syllabus in a tree/outline form for said course (see col. 25 lines 8-58).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of McGraw with the teachings of Helmick to include defining the first object by a first list of content entity identifiers organized as an outline of containers such that adding the content entity identifier of one of the second plurality of content entities to the first list outline adds the identified content entity to the first content object at a location determined by a user for the motivational purpose of an efficient and streamlined method of building a custom hierarchical outline compilation of educational materials.

With respect to independent claim 6, please refer to the rationale relied upon to reject independent claim 1. McGraw teaches the further limitations of a hierarchically structured outline as set forth in claim 6.

Specifically, McGraw teaches a custom publishing database (*compare with* "data repository") that contains a collection of modular, stand-alone text files (*compare with* "second plurality of content entities of a second hierarchically structured content object") (see pg. 3, paragraphs 1-3 → includes textbooks, supplements, journals, magazine articles, lab manuals, case studies, literary works, and historical documents each structured such that the content entities rank or grade in a subordinate manner in a "hierarchy;" see also pgs. 5-12 → i.e. discipline, volume, chapter, section, etc.) that can be mixed and matched ***in any order*** (*compare* with "at a location determined by user") and seamlessly arranged to create a custom book (*compare with* "first hierarchically structured content object") consisting of the selected modular text files (*compare with* "first plurality of content entities") (see pg. 3, bulleted features).

Independent claims 16 and 31, incorporate substantially similar subject matter as independent claim 1, and are rejected along the same rationale.

Independent claims 21 and 36, incorporate substantially similar subject matter as independent claim 6, and are rejected along the same rationale.

Regarding claims 2, 7, 17, 22, 32, 37, McGraw further teaches defining the second object by a second outline of containers (pgs. 3, 7, 9, and 12 → the available textbooks are defined in hierarchical outline form (collection of modular text files that can be mixed and matched) → book containers, chapter containers, etc.) or list of content entity identifiers (see pgs. 5-9, and 12 → each content identity is identified by a unique title or name, a unique URL, and a unique Item Identifier number).

Regarding claims 3, 8, 18, 23, 33, 38, McGraw further teaches the method, system, and a program storage device readable by a machine wherein adding an entity identifier from the second list or second outline container to the first list adds the identified content entity to the first object (pgs. 7, 9, 12 → the "Add" hyperlink adds the second list or outline to the customized textbook, as discussed above).

Regarding claims 4, 11, 19, 26, 34, 41, 49, 50, 51, McGraw teaches wherein the first object is a book, and the content entities are at least one of a volume, a chapter, and a section (see pg. 3, paragraphs 1-3 → includes textbooks, supplements, journals, magazine articles, lab manuals, case studies, literary works, and historical documents each structured such that the content entities rank or grade in a subordinate manner in a "hierarchy;" see also pgs. 5-12 → i.e. discipline, volume, chapter, section, etc.).

Regarding claims 5, 13, 14, 20, 28, 29, 35, 43, 44, McGraw further teaches a *user interface communicating with the data repository* (pgs. 5-12 → i.e. Website browser communicating with Primis database), and *providing a mechanism for selecting a content entity identifier or a container from the second list or second outline to add to a desired location in the first list through the user interface* (pgs. 7, 9, 12 → the "Add" hyperlink adds the second list or outline to a specified location in the customized textbook, as discussed above).

Regarding claims 9, 24, 39, McGraw further teaches the method, system, and a program storage device readable by a machine wherein *a first container in the second outline contains one or more containers* (pgs. 3, 5-12 → "disciplines container" contains "book containers" which further contains "chapter containers" which further contain "section containers," etc.).

Regarding claims 10, 25, 40, McGraw teaches a method, system, and a program storage device readable by a machine as explained with respect to claims 6, 7, and 9 above, but does not specifically teach the method, system, and the program storage device readable by a machine:

- wherein adding the first container to the first outline adds the content entities identified by the content entity identifiers of *all containers* in the first container to the first object.

However, McGraw teaches the outlining of textbooks into containers for the purpose of increasing the modularity of files for ease in creating a mixed and matched customized book (pgs. 3, 7, 9, 12).

It was commonly known to those of ordinary skill in the art that in hierarchical outlines each level is subordinate to the one above. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teachings of McGraw to add the content entities identified, as well as all of the content entities' dependents (i.e. full containers), in the first container object for the purpose of increasing the modularity of files for ease in creating a mixed and matched customized book.

Regarding claims 12, 27, 42, McGraw further teaches the method, system, and a program storage device readable by a machine wherein *the first and second objects are books* (pgs. 6, 8, 10) and the *containers are one or more of a book, volume, and a chapter* (pgs 7, 9, 12).

Regarding claims 15, 30, 45, McGraw further teaches a user interface communicating with the data repository, and providing a mechanism for creating a new container to add to the first outline at a desired location through the user interface (pg. 3 → allows instructors to add their own created syllabus to the first outline at a desired location by uploading it through the user interface).

Regarding claims 46-48, McGraw teaches the method, program storage device, and system wherein said first list of content identity identifiers defining the first object comprises content identity identifier names (see pgs. 5-9, and 12 → each content identity is identified by a unique title or name, a unique URL, and a unique Item Identifier number), but does not specifically teach the content identity identifier names being defined by the user.

However, McGraw teaches the compilation of a custom textbook using the instructor's own content and materials (see pgs. 1 and 3 – 2nd paragraph) for the purpose of customizing the textbook to the instructor's own personal preferences. It was commonly known to those of ordinary skill in the art that an instructor can define his own work's content entity identifier for the purpose of customizing the final textbook to the instructor's own personal preferences.

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to allow an instructor to define his own work's content entity identifier for the purpose of customizing the final textbook to the instructor's own personal preferences.

Response to Arguments

5. Applicant's arguments filed on 6/12/2006 have been fully considered but they are not persuasive.

Examiner reiterates that the independent claims, as presented, are simply so broad that they encompass most any computer-implemented file organization application. Adding content object identifiers to a content identifier list as presented in the claims is an established and basic tenet of most all hierarchical filing software applications (i.e. Windows Explorer, E-mail Applications (i.e., adding an e-mail address to a particular group mailing list), and etc.).

Applicant's instant invention appears to be an online customizable book method. It is recommended that Applicant consider making amendments, that are substantive in nature, to further define what Applicant considers to be the "inventive" subject matter of the instant invention. The independent claims, as presented, reads on most any computer-implemented file organization application.

Applicant first argues that the primary cited art, McGraw-Hill, does not disclose a customized book.

Examiner respectfully disagrees. McGraw-Hill teaches an online Primis Custom Publishing method and system to build customized textbooks (see Title and pg. 1). Therefore, McGraw-Hill teaches a customized book.

Applicant next contends that there is no indication in McGraw-Hill that a user determines the location of a content identifier when adding a second content identifier to a first content object. Applicant also contends that McGraw-Hill does not disclose wherein "the location determined by the user is between the plurality of content entity identifiers".

Examiner respectfully disagrees. McGraw teaches a custom publishing database that contains a collection of modular, stand-alone text files (see pg. 3, paragraphs 1-3; see also pgs. 5-12) that can be mixed and matched ***in any order*** (*compare* with "at a location determined by user") and seamlessly arranged to create a custom book consisting of the selected modular text files (see pg. 3, bulleted features).

Each of the "content entities" of the first and second object lists has corresponding identifiers (see pgs. 5-9, and 12). A user can determine the location of identifiers simply by adding said identifiers in any order that the user prefers. In other words, if user wanted a particular identifier in the second position, user would add said identifier second. Moreover, a user may "add" an identifier at a location between the plurality of content entity identifiers simply by resequencing (see pg. 12 – uppper right corner: "resequence" control) the identifier to a location between the other plurality of content entity identifers. This step is a new "add" and is not a subsequent "add" as Applicant contends. Assuming, *arguendo*, that this is a subsequent step, nothing in the broad claim language precludes a subsequent step.

Moreover, this limitation is taught by any generic file organization applications. Windows Explorer, for instance, is well-known by those of ordinary skill in the art at the time the invention was made to allow users to add a first file identifier to any location amongst a second list of (including between other file identifiers) by means of a hierarchical tree GUI file organization application.

Applicant further contends that the combination of McGraw-Hill and Helmick do not disclose the relationship between a first content object and a second content object. Examiner respectfully disagrees.

Once again, the metes and bounds of a first content object and a second content object are unlimited. Helmick teaches an on-line educational system for display of educational materials wherein a user can use a course manager screen in order to build an electronic syllabus (see Figs. 3V-3X). Fig. 3X specifically teaches an add content screen used to add or modify content for particular identified units of a course and thus build a syllabus in a tree/outline form for said course (see col. 25 lines 8-58).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of McGraw with the teachings of Helmick to include defining the first object by a first list of content entity identifiers organized as an outline of containers such that adding the content entity identifier of one of the second plurality of content entities to the first list outline adds the identified content entity to the first content object at a location determined by a user for the

motivational purpose of building a custom hierarchical outline compilation of educational materials.

Finally, Applicant argumentatively contends that it is not inherent for content to be stored in a data repository or memory.

Examiner respectfully disagrees because without the storage of the objects in a data repository (memory, cache, etc.) for immediate or later retrieval the instant invention would cease to function.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Nguyen-Ba whose telephone number is (571) 272-4094. The examiner can normally be reached on 11 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PNB
8/25/06

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